Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY M. SKERGAN

Appeal No. 1998-1907
Application No. 08/353,008

ON BRIEF

Before HAIRSTON, FLEMING, and RUGGIERO, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 14.

The disclosed invention relates to a method and system for selecting a point within a display device of a data processing system. During the selection of the point, a plurality of graphical pointers are displayed within the display device.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. An improved method of selecting points within a display device of a data processing system, said data processing system including a single graphical pointing device, comprising:

displaying a plurality of graphical pointers within said display device;

temporarily selecting one graphical pointer among said plurality of graphical pointers;

manipulating said one graphical pointer in response to operation of said single graphical pointing device during said selection of said one graphical pointer; and

selecting a point within said display device in response to closure of a switch associated with said one graphical pointer among said plurality of graphical pointers, said point specified by a position of said one graphical pointer.

The references relied on by the examiner are:[1]

Claris Corp., MacDraw Pro User's Guide, pp. 1-24, 3-20 and 3-21 (1991)(hereinafter Claris).

Macintosh MacPaint[2], 16 unnumbered pages (hereinafter Apple).

Claims 1 through 5 and 10 through 14[3] stand rejected under

---

[1] The statement of the prior art of record (answer, page 2) mistakenly omits the references of record.

[2] Appellant has not challenged the lack of a publication date on this reference. Therefore, we assume that the date of this publication is before the application filing date.

[3] The statement of the rejection (answer, page 3) mistakenly lists a claim 15.

35 U.S.C. § 102(b) as being anticipated by Claris.

Claims 6 through 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Apple.

Reference is made to the briefs and the answers for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will sustain the 35 U.S.C. § 102(b) rejection of claims 1 through 5 and 10 through 14, and we will reverse the 35 U.S.C. § 102(b) rejection of claims 6 through 9.

The examiner is of the opinion (answer, page 3) that scroll arrows in Claris (Figure 1-17) are a "plurality of graphical pointers" as set forth in claims 1 through 5 and 10 through 14. Appellant argues (brief, page 7) that:

> Assuming for the sake of argument that the term "graphical pointer" can be interpreted in the manner proposed by the Examiner, *Claris* still does not show or suggest the step of "selecting a point within said display device in response to closure of a switch associated with said one graphical pointer . . . said point specified by a position of said one graphical pointer," as recited in Claim 1. According to the Examiner, *Claris'* graphical objects correspond to the plurality of graphical pointers recited in Claim 1. Thus, in order to be consistent, *Claris* must also teach the selection of a point within a display device in response to closure of a switch associated [sic, with] a graphical object, where the location of the selected point is specified by the position of the graphical

> object. It is clear from even a cursory review of *Claris* that this is not what *Claris* teaches. Instead, *Claris* teaches the conventional selection of a point specified by the location of a single graphical pointer. Applicant therefore urges the Board that *Claris* does not render the present invention unpatentable.

We agree with appellant that Claris teaches "the conventional selection of a point specified by the location of a single graphical pointer" (Figure 1-17). On the other hand, we agree with the examiner that the scroll arrows in Claris (Figure 1-17) are graphical pointers that lie within the display device. Although the scroll arrows can not be used to select a point, the noted "single graphical pointer" can certainly perform the function of selecting "a point." The claims on appeal do not require that each of the graphical pointers be capable of selecting "a point." Thus, the 35 U.S.C. § 102(b) rejection of claim 1 is sustained. The 35 U.S.C. § 102(b) rejection of claims 2 through 5 and 10 through 14 is likewise sustained because appellant has chosen to let these claims stand or fall with claim 1 (brief, page 5).

Turning to the 35 U.S.C. § 102(b) rejection of claim 6, we agree with appellant's argument (brief, page 8) that "the Examiner fails to specifically indicate what features disclosed by *Apple* are relied upon as teaching the plurality of graphical

pointers recited in the present claims." Accordingly, the 35 U.S.C. § 102(b) rejection of claim 6 is reversed because we will not resort to speculation and assumptions concerning the examiner's intentions and interpretation of the teachings of the Apple publication. As a result of the reversal of the rejection of claim 6, it follows that the 35 U.S.C. § 102(b) rejection of claims 7 through 9 is reversed.[4]

DECISION

The decision of the examiner rejecting claims 1 through 14 under 35 U.S.C. § 102(b) is affirmed as to claims 1 through 5 and 10 through 14, and is reversed as to claims 6 through 9. Accordingly, the decision of the examiner is affirmed-in-part.

[4] The examiner's statement (answer, page 5) that claims 6 through 9 "could be rejected using Claris" is duly noted, but we decline to issue a rejection that the examiner could have issued in the first instance.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON)
Administrative Patent Judge)
)
)
MICHAEL R. FLEMING) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
JOSEPH F. RUGGIERO)
Administrative Patent Judge)

KWH:hh

Appeal No. 1998-1907
Application No. 08/353,008

ANDREW J. DILLON
FELSMAN, BRADLEY, GUNTER & DILLON, LLP
Suite 350, Lakewood on the Park
7600B North Capital of Texas Highway
Austin, TX 78731